

REMARKS

In an Office Action mailed on December 3, 2003, objections were made to claims 8 and 19; claims 16-18 were objected to as being allowable if rewritten in independent form; claims 1-5 and 7-13 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lacy in view of Gartstein; claims 14 and 15 were rejected under 35 U.S.C. § 102(e) as being anticipated by Jones; and claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lacy in view of Takabayashi. Claims 2 and 9 have been cancelled; and claims 18 and 19 have been renumbered as claims 17 and 18, respectively, to overcome the claim objections.

The Examiner rejects dependent claim 6 under 35 U.S.C. § 103(a) in view of the combination of Lacy and Takabayashi. However, dependent claim 6 overcomes the § 103 rejection for at least the reason that Lacy is not prior art for purposes of 35 U.S.C. § 103(a). More specifically, 35 U.S.C. § 103(c) states that subject matter developed by another which qualifies as prior art only under § 102(e) is not be applied as prior art provided that the subject matter and the claimed invention were commonly owned at the time of the invention was made. M.P.E.P. § 2146. This is the case here, as the subject matter disclosed in Lacy and the invention claimed in the present application were both owned by Plug Power, Inc. at the time the claimed invention was made. Attached hereto is a copy of the Notice of Recordation of Assignment, showing ownership of the present application by Plug Power, Inc. Thus, for at least this reason, dependent claim 6 overcomes the § 103 rejection. Claim 6 is further patentable for at least the reason that this claim depends from an allowable independent claim, as discussed below.

Rejections of Claims 1 and 3-7:

As amended, the fuel cell system of independent claim 1 includes a first circuit that is adapted to selectively connect the battery to the load and isolate the battery from the load based on a response of the fuel cell subsystem to a change in the power that is furnished to the load.

Contrary to the limitations of amended independent claim 1, Lacy discloses a fuel cell system in which the battery 60 remains connected to the load of the disclosed fuel cell system. Although Lacy describes the battery 60 as supplying additional current, when needed, it is noted that the battery 60 is depicted as always remaining connected to the load. Thus, Lacy fails to teach a circuit to selectively connect a battery to a load and isolate the battery from a load. Therefore, Lacy fails to anticipate independent claim 1.

Claims 3-7 are patentable for at least the reason that these claims depend from an allowable claim. Thus, withdrawal of the §§ 102 and 103 rejections of claims 1 and 3-7 is requested.

Rejections of Claims 8 and 10-13:

As amended, the method of independent claim 8 includes selectively connecting a battery to a load and isolating the battery from the load based on a response of a fuel cell stack to a change in the power furnished to the load.

Contrary to the limitations of amended independent claim 1, Lacy does not teach or even suggest that the battery 60 is selectively connected and isolated from a load to the disclosed fuel cell system. Instead, the battery 60 is depicted as being permanently connected to the fuel cell system and thus, Lacy fails to disclose the limitations of amended independent claim 8.

Claims 10-13 are patentable for at least the reason that these claims depend from an allowable claim. Thus, withdrawal of the § 102 rejections of claims 8 and 10-13 is requested.

Rejections of Claims 14 and 15:

The Examiner rejects independent claims 14 and 15 under 35 U.S.C. § 102(e) in view of Jones. However, Jones has an effective U.S. filing date of December 27, 2000, a date that is *after* March 31, 2000, the filing date of the provisional application to which the present application claims priority. Therefore, for at least the reason that Jones is not prior art against the present application, withdrawal of the § 102 rejections of claims 14 and 15 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge Deposit Account No. 20-1504 (PLUG-0037-US).

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Respectfully submitted,

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